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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/781,284  | 02/13/2001  | Mikio Hashimoto      | 203058US2RD         | 9450             |
| 22850   | 7590        | 04/22/2005           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | SON, LINH L D       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2135                |                  |

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                  |
|------------------------------|-----------------|------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)     |
|                              | 09/781,284      | HASHIMOTO ET AL. |
|                              | Examiner        | Art Unit         |
|                              | Linh LD Son     | 2135             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 01 December 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)  
 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. This written action is responding to the amendment received on December 1st, 2004.
2. Claims 1-19 are pending. Claims 1, 7, 13, 14, and 18 are amended.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4-8, and 10-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan, US Patent No. 6473860B1.
4. As per claims 1, 7, 13, and 14, Chan teaches "A program distribution system, comprising: a program distribution device connected to a network, for distributing executable programs through the network" in (Col 3 lines 25-35); and "a client device connected to the network, for receiving the executable programs distributed from the program distribution device through the network" in (Col 3 lines 25-35); "wherein the client device has: a tamper resistant processor which is provided with a unique secret key and a unique public key corresponding to the unique secret key in advance" in (Col 3 lines 47-60, and Col 4 lines 27-30); "a client side first communication path set up unit configured to set up a first communication path between the program distribution device and the client device; a client side second

communication path set up unit configured to set up a second communication path directly connecting the program distribution device and the tamper resistant processor; the first and second communication paths being, set up as different channels on an identical transmission line or as different transmission lines; and a program receiving unit configured to receive an encrypted program from the program distribution device through the second communication path" in (Col 9 lines 50-60, and Col 10 lines 4-10); and "the program distribution device has: a server side first communication path set up unit configured to set up the first communication path between the program distribution device and the client device" in (Col 3 lines 25-60); "a server side second communication path set up unit configured to set up the second communication path directly connecting the program distribution device and the tamper resistant processor, on the first communication path" in (Col 3 lines 50-55, and Col 4 lines 25-34); "an encryption processing unit configured to produce the encrypted program by encrypting an executable program to be distributed to the client device and executed within the tamper resistant processor, by using the unique public key of the tamper resistant processor" in (Col 4 lines 25-34 and Col 7 lines 45-57); and "a transmission unit configured to transmit the encrypted program to the tamper resistant processor through the second communication path so that the encrypted program is directly delivered to the tamper resistant processor and the encrypted program can be decrypted and executed within the tamper resistant processor which is an only

entity that has the unique secret key corresponding to the unique public key" in (Col 9 lines 50-61, Col 9 line 62 to Col 10 line 45).

5. As per claim 2, Chan teaches "The program distribution device of claim 1, further comprising: a user authentication unit configured to carry out authentication of a user who is using the client device, by using a user ID of the user received from the client device through the first communication path" in (Col 9 line 50 to Col 10 line 3).
6. As per claim 4, Chan teaches "The program distribution device of claim 1, wherein the encryption processing unit encrypts the executable program by using the unique public key received from the tamper resistant processor through the second communication path" in (Col 10 lines 25-35).
7. As per claim 5, Chan teaches "The program distribution device of claim 1, wherein the encryption processing unit encrypts the executable program by using a common key, and encrypts the common key by using the unique public key received from the tamper resistant processor through the second communication path; and the transmission unit transmits the encrypted program along with an encrypted common key to the tamper resistant processor through the second communication path" in (Col 10 lines 4-35).

8. As per claim 6, Chan teaches "The program distribution device of claim 1, wherein communications through the second communication path are cipher communications" in (Col 7 lines 45-55).
9. As per claim 8, Chan teaches "The client device of claim 7, further comprising: a user authentication unit configured to carry out authentication of a user who is using the client device with respect to the program distribution device, by transmitting a user ID of the user to the program distribution device through the first communication path" in (Col 9 lines 50-60).
10. As per claim 10, Chan teaches "The client device of claim 7, wherein the program receiving unit receives the encrypted program which is encrypted by using the unique public key notified from the tamper resistant processor to the program distribution device through the second communication path" in (Col 7 lines 45-55).
11. As per claim 11, Chan teaches "The client device of claim 7, wherein the program receiving unit receives the encrypted program which is encrypted by using a common key, and an encrypted common key which is encrypted by using the unique public key notified from the tamper resistant processor to the program distribution device through the second communication path" in (Col 10 lines 24-35, and Col 7 lines 45-55).

12. As per claims 12 and 19, Chan teaches “The client device of claims 7 and 14, wherein communications through the second communication path are cipher communications” in (Col 10 lines 24-35, and Col 7 lines 45-55).
13. As per claim 17, Chan teaches “The method of claim 14, wherein the producing step encrypts the executable program by using the unique public key received from the tamper resistant processor through the second communication path” in (Col 10 lines 24-35, and Col 7 lines 45-55).
14. As per claim 18, Chan teaches “The distribution device method of claim 14, wherein the producing step encrypts the executable program by using a common key, and encrypts the common key by using the unique public key received from the tamper resistant processor through the second communication path; and the transmitting step transmits the encrypted program along with an encrypted common key to the tamper resistant processor through the second communication path” in (Col 10 lines 24-35, and Col 7 lines 45-55).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Guthery, US Patent No. 6567915B1.
  
17. As per claims 3 and 9, Chan teaches "The program distribution device of claims 1 and 7, further comprising: a processor authentication unit configured to carry out authentication of the tamper resistant processor verifying that the tamper resistant processor surely has the unique secret key and the unique public key, which is received from the client device through the second communication path" in (Col 9 lines 50-55). However, Chan is silent on "the verifying step by verifying a certificate certifying that the tamper resistant processor surely has the unique secret key and the unique public key, which is received from the client device through the second communication path". Nevertheless, Guthery fully discloses the verification steps that use the certificate for authentication (Fig 1-4, Col 11 line 64 to Col 12 line 15). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Chan's invention to include the certificate verifying capability to prevent illegal client device connecting to the program distribution network.

***Response to Amendment***

18. Applicant has amended claims 1, 7, 13, 14, and 18, which necessitated new grounds of rejection. See Rejections above.

***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Conclusion**

21. Any inquiry concerning this communication from the examiner should be directed to Linh Son whose telephone number is (571)-271-3856.
22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Y. Vu can be reached at (571)-272-3859. The fax numbers for this group are (703)-872-9306 (official fax). Any inquiry of general nature or relating to

the status of this application or proceeding should be directed to the group receptionist whose telephone number is (571)-272-2100.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval PAIR.I system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pzs-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Linh LD Son**

**Patent Examiner**



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